



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/568,779	09/29/2009	David Birkenstock	BIRK-003-DIV	7068

62008 7590 02/02/2017
MAIER & MAIER, PLLC
345 South Patrick Street
ALEXANDRIA, VA 22314

EXAMINER

DINH, TIEN QUANG

ART UNIT	PAPER NUMBER
----------	--------------

3647

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

02/02/2017

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patent@maierandmaier.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DAVID BIRKENSTOCK

Appeal 2015-000855
Application 12/568,779
Technology Center 3600

Before JILL D. HILL, JEFFREY A. STEPHENS, and
PAUL J. KORNICZKY, *Administrative Patent Judges*.

HILL, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

David Birkenstock (Appellant) appeals under 35 U.S.C. § 134 from the Examiner's decision rejecting claims 1–6 and 8–13.¹ We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

¹ Claim 7 was canceled. Br. 10 (Claims App.).

BACKGROUND

Sole independent claim 1, reproduced below, represents the claimed invention.

1. A flow modifying system, comprising:
 - a cover for covering an aircraft body over which fluid flows;
 - a shape on the cover that stimulates flow impingement on a trailing edge of the cover, wherein the trailing edge is substantially concave;
 - a flow driving mechanism disposed on the trailing edge;and
 - a control surface on the cover.

REJECTIONS

I. Claims 1–6 and 8–13 stand rejected under 35 U.S.C. § 112(b) as indefinite. Final Act. 2.

II. Claims 1–6, 8, 12, and 13 stand rejected under 35 U.S.C. § 102(b) as anticipated by Favre (US 2,569,983, iss. Oct. 2, 1951). Final Act. 3.

III. Claims 9–11 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Favre and Stroukoff (US 2,841,344, iss. July 1, 1958). Final Act. 3.

OPINION

Rejection I

The Examiner finds that claim 1 recites a control surface “on the cover,” but that the figures seem to show the cover being on the control surface. Final Act. 2. The Examiner considers it “apparent that ‘a control surface on the cover’ is incorrect,” rendering the claims indefinite. *Id.*

Appellant argues that Figure 3 is described in paragraph 33 of the Specification as follows: “The airfoil 130 is covered by a glove 100, which has . . . a hinged control surface 110.” Br. 4.

The Examiner disagrees, because Figure 3 shows the control surface 110 being covered by (or inside of) the glove. Ans. 2.

We agree with Appellant. Claim 1 recites the control surface being “on” the glove, not “outside of” the glove. We see no reason why the control surface is not disclosed as being on (i.e., attached to) the glove, despite being illustrate at a location within the glove. We, therefore, do not sustain Rejection I.

Rejection II

The Examiner finds that Favre discloses a cover (rear panel 4) having a shape that stimulates trailing edge flow impingement, a control surface (roll 2, rotary discs 47) on the cover, and a flow driving mechanism (rolls 5) disposed on the trailing edge. Final Act. 3. The Examiner finds that Favre’s system can be used on an aircraft body. *Id.*

Appellant argues that the Examiner relies on elements of Favre that are for automobiles, not aircraft bodies. Br. 5. Appellant thus argues that the Examiner erred in finding that Favre’s system can be used on an aircraft body. We note that the embodiment of Favre on which the Examiner relies in the rejection includes the automobile of Favre’s Figures 1–3.

The Examiner responds that the recitation of “for covering an aircraft body” is an intended use limitation and carries little patentable weight. Ans. 2.

We agree with Appellant. While the recitation of “for covering an aircraft body” is an intended use limitation, the limited weight given to

intended use limitations is based on the principle that a new use for an old product does not render an old product patentable. *See In re Schreiber*, 128 F.3d 1473, 1477 (citing *In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990)). Notably, in *Schreiber*, the product required no rearrangement or substantial modification to perform the new use.

Here, the Examiner does not contend, nor is it readily apparent from the disclosure of Favre, that the system of Favre's Figures 1–3 can be used on an aircraft body without substantial modification. Even if it is true that the concepts of Favre can be applied to an aircraft body, we are not persuaded that the embodiment of Favre's Figures 1–3 can be used in a substantially unmodified configuration on an aircraft body. We, therefore, are not persuaded that the Examiner has established *prima facie* anticipation.

Rejection III

Claims 9–11 depend from claim 1. The Examiner does not find that Stroukoff, though directed to an aircraft, cures the above-noted deficiency of Favre. We, therefore, do not sustain Rejection III for the reasons explained above regarding Rejection II.

DECISION

We REVERSE the rejection of claims 1–6 and 8–13 under 35 U.S.C. § 112(b) as indefinite.

We REVERSE the rejection of claims 1–6, 8, 12, and 13 under 35 U.S.C. § 102(b) as anticipated by Favre.

We REVERSE the rejection of claims 9–11 under 35 U.S.C. § 103(a) as unpatentable over Favre and Stroukoff.

Appeal 2015-000855
Application 12/568,779

REVERSED